

REMARKS/ARGUMENTS

The Office Action mailed April 20, 2004 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Claim Status and Amendment to the Claims

Claims 1-4, 15-20, 27-32, 36 and 38-46 are now pending.

Claims 5-14, 21-26, 33-35 and 37 had been withdrawn from further consideration as the result of an earlier restriction requirement.

Applicants gratefully acknowledge the indication of allowable subject matter in claim 41-43 if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants are further grateful for the indication of allowability of claims 38-43 and 44-46, subject to the 35 U.S.C. §112 issues outlined in the Office Action and to their rewriting in independent form.

Claims 38 and 44-46 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification, page 41, line 17 to page 42, line 16.

New claims 47-48 have been added, which also particularly point out and distinctly claim subject matter regarded as the invention. Support for these claims may be found in the specification, page 42, lines 4-11.

No "new matter" has been added by the amendment.

The 35 U.S.C. § 112, Second Paragraph Rejection

Claims 38-40 and 44-46 stand rejected under 35 U.S.C. § 112, second paragraph, as

allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.

Claim 38 has been amended in accordance with the Examiner's suggestion. This amendment also clarify dependent claims 39-40.

Claims 44-46 have been amended so as to clarify the elements (means) and their function of the first network device (corresponding to the commander network device). Please note that both the commander network device and the member network device may monitor for address conflicts, as described on page 41, lines 17-19 of the present specification.

With this amendment, withdrawal of the 35 U.S.C. §112, second paragraph, rejection is respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 1-4, 15-20, 27-32 and 36 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lecheler et al. (U.S. Pat. 6,425,008) in view of Daruwalla (U.S. Pat. 6,693,878), among which claims 1, 15, 27 and 36 are independent claims. This rejection is respectfully traversed.

According to M.P.E.P. §2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Claim 1 defines a method for assigning private Internet Protocol (“IP”) addresses to network devices in a cluster, each of the network devices being capable of interconnecting at least two network segments and forwarding data frames from one network segment to another. The claimed method comprises (a) reading the Media Access Control (“MAC”) address of a first network device, (b) generating a private IP address as a function of said MAC address, (c) assigning said private IP address to said first network device, and (d) communicating with said first network device using said private IP address, as recited in claim 1 as amended.

In the Office Action, the Examiner specifically contends that the elements of the presently claimed invention are disclosed in Lecheler except that Lecheler does not teach that the private IP address is calculated as a function of the MAC address. The Examiner further contends that Daruwalla discloses the private IP address is calculated as a function of (based on) the MAC address and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Daruwalla into Lacheler so that the assigning of the private IP address will be simpler and the matching of IP address to MAC can be easier. The Applicants respectfully disagree for the reasons set forth below.

The Applicant hereby respectfully asserts that the cited reference Daruwalla is disqualified from being used as a prior art reference in this context under 35 U.S.C. §103(c) for the following reason:

This rejection combines Lecheler with Daruwalla under 35 U.S.C. §103(a). Section 103(c) (effective November 29, 1999) states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As can clearly be seen on the first page of the Daruwalla reference, it has assigned at issue to Cisco Technology, Inc. and a search of the Patent Office records will confirm that it still is so assigned. Accordingly, since Daruwalla was filed on October 15, 1999 and issued February 17, 2004 whereas the instant invention was filed on November 30, 1999, three things must be true: First, the Daruwalla reference is potentially a reference only under 35 U.S.C. §102(e) because it wasn't a published document for a year prior to the filing of this case; second, both this case and Daruwalla were owned, at the time the present invention was made, by the same entity; and third, this case is subject to 35 U.S.C. §103(c) since it was filed after the new provision of 35 U.S.C. §103(c) became effective.

As sufficient evidence to establish common ownership (MPEP §706 (l)(2)), a STATEMENT CONCERNING OWNERSHIP signed by an attorney of record, David B. Ritchie, Reg. No. 31,562, is attached wherewith as a separate sheet.

Accordingly, 35 U.S.C. §103(c) applies and Daruwalla is disqualified as being used as prior art. Since a prima facie case of obviousness cannot be established, it is respectfully requested that the §103 rejection of claims based on Lecheler and Daruwalla be withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Dependent Claims

Claims 2-4 depend from claim 1, claims 16-20 depend from claim 15, and claims 28-32 depend from claim 27, and thus include the limitations of respective independent claims. The argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable at least for the same reasons.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,
THELEN REID & PRIEST, LLP

Dated: July 20, 2004



Masako Ando

Limited Recognition Under 37 CFR §10.9(b)

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Docket No.: CISCO-1656
(032590-000085)

STATEMENT CONCERNING COMMON OWNERSHIP

I, David B. Ritchie, an attorney of record for U.S. Patent Application No. 09/452,284, hereby state, as evidence to establish common ownership, pursuant to the M.P.E.P §706.02(l)(2), as follows:

U.S. Patent Application No. 09/452,284 and U.S. Patent No. 6,693,878 (Daruwalla et al.) were, at the time the invention of U.S. Patent Application No. 09/452,284 was made, owned by, or subject to an obligation of assignment to, Cisco Technology, Inc.

Dated: July 20, 2004

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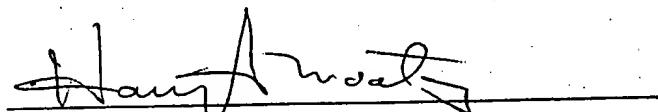
BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Masako Ando is hereby given limited recognition under 37 CFR § 10.9(b) as an employee of Thelen, Reid & Priest LLP to prepare and prosecute patent applications wherein the patent applicant is the client of Thelen, Reid & Priest LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of Thelen, Reid & Priest LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Masako Ando ceases to lawfully reside in the United States, (ii) Masako Ando's employment with Thelen, Reid & Priest LLP ceases or is terminated, or (iii) Masako Ando ceases to remain or reside in the United States on an H-1 visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: August 27, 2004



Harry I. Moatz
Director of Enrollment and Discipline